



Paper No. 8

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OFFICE OF PETITIONS

In re Application of	: DECISION GRANTING PETITION
Peterson et al.	: UNDER 37 CFR 1.53(b).
Application No. 09/708,713	: AND REFUSING STATUS
Filed: 9 November, 2000	: UNDER 37 CFR 1.47(b)
Atty Dckt No. 47382.000111	:

This is in response to the petition filed on 11 October, 2001, requesting that the above-identified application be accorded a filing date of 9 November, 2000. This is also a decision on the petition under 37 CFR 1.47(b) filed on 13 November, 2001,

The petition under 37 CFR 1.53(b) is **GRANTED**.

The petition under 37 CFR 1.47(b) is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

PETITION UNDER 37 CFR 1.53(b)

The application was deposited on 9 November, 2000. On 10 April, 2001, Initial Patent Examination Division mailed a Notice of Incomplete Nonprovisional Application, stating that the application had not been accorded a filing date because the

specification was missing.

A review of the official file reveals that a copy of the specification, including claims, and drawings of U.S. Patent 5,726,450, of which this application is a continuation of a reissue application, is located among the application papers received on 9 November, 2000. As such, the application was complete on 9 November, 2000, and entitled to a filing date of that date.

PETITION UNDER 37 CFR 1.47(b)

In response to the Notice of Incomplete Application filed on 10 April, 2001, which required a signed oath or declaration, petitioners filed on 13 November, 2001,¹ the present petition, accompanied by a declaration naming Jay Peterson, David R. Nelson, Troy P. Bahan, George C. Polchin, and Michael D. Jack as joint inventors and signed by petitioners' registered patent attorney, Christopher Cuneo, on behalf of Environmental Systems Products Holdings, Inc., parent corporation of assignee Envirotest Systems Corporation, and a petition for a five (5) month extension of the time to reply to the Notice of Incomplete Application.

Petitioners assert that a copy of reissue Application No. 09/521,858, a preliminary amendment, and the declaration for the present application was sent to each of the inventors. Petitioners assert that joint inventors Peterson, Nelson, Polchin, and Jack failed to sign and return the declaration. Petitioners further assert that the papers sent to joint inventor Bahan were returned as undeliverable. Petitioners have also shown that the inventors assigned their interest in the invention to HE Holdings, Inc. DBA Hughest Electronics, which assigned its interest to Hughes Aircraft Company, which in turn assigned its interest to Envirotest Systems Corporation.

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35

¹10 November, 2001, fell on a Saturday, and 12 November, 2001, fell on a Federal holiday, so the response filed on 13 November, 2001, was timely filed. See 37 CFR 1.7(a).

U.S.C. §§ 115 and 116;

- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest, and
- (6) proof of irreparable damage.

The petition lacks item (1).

In regards to item (1), petitioner has not provided sufficient proof that a copy of the application as filed was sent or given to the non-signing inventor for review.²² Rather, the declaration of petitioners' registered patent counsel, Christopher Cuneo, is that a copy of the prior application, No. 09/521,858, was sent to the inventors and that subsequently an amendment and the declaration for the present application was sent to each of the inventors. Before a *bona fide* refusal to sign can be alleged, petitioners must show that a copy of the application as filed (specification, including claims, drawings, if any, and the declaration) must be sent or given to each joint inventor.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventors by providing a copy of the cover letter transmitting the application papers to the non-signing inventors or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Likewise, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, petitioners must provide a copy of that written refusal with any renewed petition. If the refusal is made orally, then the person to whom the refusal was made must provide details of the refusal in an affidavit or a declaration of facts.

Additionally, a brief Internet search shows that joint inventor Bahan, whom petitioners assert could not be found, may be living in Goleta, CA. Petitioners should investigate whether a more recent address is available for joint inventor Bahan. If a current address is found, a copy of the application papers should be sent to joint inventor Bahan at the last known address. If continued attempts to send or give a copy of the application to, and obtain an executed declaration from, Bahan fail, then

²²MPEP 409.03(d).

petitioner will have shown a refusal to sign the declaration based on conduct. The proof of pertinent events should be made by an affidavit or declaration of facts by a person with first-hand knowledge of the details.

Although petitioners submitted a check for \$2,220.00 with the petition filed on 13 November, 2001, that check was returned as unpaid on 19 November, 2001. As a result, counsel's deposit account, No. 50-0311, will be charged \$1,960.00 for the five (5) month extension of time, \$130.00 for the petition under 37 CFR 1.47(b) fee, \$130.00 for the late filing surcharge, and the \$50.00 processing fee due for a returned check. The \$130.00 fee for the petition under 37 CFR 1.53 filed on 11 October, 2001, will be refunded to counsel's deposit account.

It is additionally noted that although this application is a continuation of a reissue application, it was not processed with a reissue application folder. The application will be returned to OIPE for reprocessing in a reissue application folder after a grantable petition under 37 CFR 1.47(a) is filed.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to Douglas I. Wood at (703)308-6918.


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